

GRTSTF.011A



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Weatherill et al.
Appl. No. : 09/777,420
Filed : February 6, 2001
For : REEL HOUSING WITH
DECORATIVE ACCESS PANEL
Examiner : John Quoc Nguyen

Group Art Unit 1765

I hereby certify that this correspondence and all
marked attachments are being deposited with
the United States Postal Service as first-class
mail in an envelope addressed to: Mail Stop
INTERFERENCE, Board of Patent Appeals and
Interferences, United States Patent and
Trademark Office, PO Box 1450, Alexandria,
VA 22313-1450, on

March 9, 2004

(Date)

Sanjivpal S. Gill

Sanjivpal S. Gill, Reg. No. 42,578

ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANT'S BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
MAR 19 2004
GROUP 3600

Dear Sir:

This Appeal Brief relates to an appeal to the Board of Patent Appeals and Interferences of the final rejection set forth in an Office Action mailed October 10, 2003 in the above-captioned application.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee of this application, Great Stuff, Inc.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals or interferences.

Appl. No. : **09/777,420**
Filed : **February 6, 2001**

III. STATUS OF THE CLAIMS

The above-captioned application was originally filed with Claims 1-20. In the course of prosecution Claim 21, and then Claims 22-28, were added and Claims 24 and 26 were subsequently canceled. Claims 1-23, 25, and 27-28 are thus pending in the present application and were finally rejected in the Office Action dated October 10, 2003. In the final Office Action, the Examiner rejected all of the pending claims under 35 U.S.C. § 103(a). In particular, Claims 1-23, 25, and 28 were rejected over U.S. Patent No. 2,403,277 to Hall ("Hall"), and Claim 27 was rejected over Hall in view of U.S. Patent No. 2,286,277 to Ewald ("Ewald"). The final rejection was affirmed in an Advisory Action dated January 5, 2004.

Accordingly, Claims 1-23, 25, and 27-28 are the subject of this appeal. These pending claims are attached hereto as Appendix A.

IV. STATUS OF AMENDMENTS

The claims before the Board appear as they were finally rejected. As noted above, these pending claims are attached hereto as Appendix A.

V. SUMMARY OF THE INVENTION

The claimed invention relates generally to reels for spooling linear material, and more particularly to reel housings for garden hoses or electrical cables.

In the past, reels have been used for spooling linear material, such as hoses or wires. Many of such reels comprise a rotating reel drum enclosed within a housing during operation. A variety of different types of housings have been used. For example, reel housings have had many different shapes, such as cylindrical, rectangular, octagonal, etc. Generally, there has been very little effort expended in improving the aesthetic appearance of reel housings, especially those of garden hose and cable reels. In addition, little effort has been devoted to reel configurations which integrate functional components of the reel with an improved aesthetic appearance.

Appellants have provided a linear material reel having, *inter alia*, a housing with facial indicia which incorporates functional components of the reel in order to improve the aesthetic appearance of the reel housing, while maintaining the functionality of the reel. Specifically, in the present application, Appellants recite aesthetic, yet functional, features, such as the location of the facial indicia with respect to a functional access panel and a functional aperture within the

Appl. No. : **09/777,420**
Filed : **February 6, 2001**

facial indicia. For example, Claim 1 recites an “aperture ...within said facial indicia” which is “sized to closely surround spoolable linear material...so that the linear material can be spooled onto and unspooled from the reel drum while said housing encloses the reel drum,” while Claim 14 recites an aperture within said facial indicia “through which the linear material is spooled or unspooled.” Claims 21 and 25 recite that the “aperture ...within said facial indicia” is “sized to closely receive spoolable linear material.” Furthermore, other features which are both aesthetic and functional in nature are recited, such as removable (Claim 21) or detachable (Claim 25) facial indicia and/or a removable access panel (Claim 14) decorated with facial indicia.

VI. ISSUES BEFORE THE BOARD

The primary issue before the Board in this appeal is whether the Examiner has provided a suggestion or motivation in the prior art for modifying the primary reference, Hall, to have facial indicia and an aperture as claimed, as required to establish a *prima facie* case of obviousness.

VII. GROUPING OF CLAIMS

For the purposes of the present appeal, Claims 1-23, 25, 27, and 28 stand and fall together. Appellants reserve the right, however, to separately argue, in subsequent continuing applications, the patentability of various dependent features not addressed herein.

VIII. APPELLANTS' ARGUMENT

A. Rules For Obviousness Rejections

It is well settled that, in order to support an obviousness rejection, the Examiner must provide a *prima facie* case:

To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some *suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, *the prior art reference* (or *references when combined*) *must teach or suggest all the claim limitations*. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Appl. No. : 09/777,420
Filed : February 6, 2001

M.P.E.P §706.02(k) (emphasis added). *See, also,* M.P.E.P §2143.03. If any one of these three showings is absent or deficient, the obviousness rejection *cannot stand*.

Of particular importance in our analysis is the required showing of a specific motivation or suggestion to modify the prior art. The Federal Circuit has ruled that “[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for showing of the teaching or motivation to combine prior art references.” *In re Dembicza*k, 50 U.S.P.Q. 2d., 1614, 1617 (Fed. Cir. 1999). The Court has ruled that “the showing [of obviousness] must be *clear and particular*” and that “[b]road conclusory statements concerning the teaching of multiple references, standing alone, *are not ‘evidence.’”* *Id.* (emphasis added).

When obviousness is based upon a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). The motivation, suggestion, or teaching to combine prior art elements, as would support a finding of obviousness, may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved. *Id.* In addition, the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. *Id.* The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *Id.* Whether the obviousness rejection relies on an express or an implicit showing of some motivation, suggestion, or teaching to combine prior art elements, it must provide particular findings related thereto. *Id.* Broad conclusory statements standing alone are not evidence. *Id.* Although a prior art device may be capable of being modified to achieve the claimed structure, there must be a suggestion or motivation in the reference for doing so. *In re Mills*, 16 U.S.P.Q. 2d 1430, 1432 (Fed. Cir. 1990).

There is no per se rule of obviousness for aesthetic design elements. In *In re Dembicza*k, 50 U.S.P.Q. 2d. at 1617, the Court reversed the Board’s obviousness rejection of claims directed to a generally round, orange, plastic trash bag decorated with a jack-o-lantern face. The Court found that the Examiner failed to provide a *clear and particular showing* of a suggestion or motivation to combine conventional trash bags with a reference showing a jack-o-lantern face on an orange paper bag stuffed with newspapers. *Id.* (emphasis added).

Appl. No. : **09/777,420**
Filed : **February 6, 2001**

B. The Cited References

Hall teaches a traffic counter having a pneumatic rubber hose 31 and a square housing. During operation, the front wall 2 is removed and the tube 31 is then unspooled or spooled. The wall 2 is replaced after the tube is unspooled. The front wall contains a U-shaped opening 17 or notch at a bottom edge of the front wall 2 that partially surrounds the tube 31 when the front wall 2 is replaced, but does not partially surround the tube 31 during spooling or unspooling. Hall does not teach or suggest anything about facial indicia, functional or otherwise.

Ewald has been cited to provide a generally spherical housing, as recited by Claim 27. Ewald teaches a hose reel having an ovular housing, but does teach or suggest anything about facial indicia, functional or otherwise.

C. The Examiner has failed to show a suggestion or motivation to modify Hall to include a reel housing having facial indicia and an aperture located therein.

All of Appellants' claims recite "facial indicia." Claim 1 recites, *inter alia*, an access panel having facial indicia to resemble one of an animal, a human, a human-like character, and an alien creature, as well as an aperture sized to closely surround spoolable linear material extending through the aperture. Claim 14, *inter alia*, recites an access panel having an exterior surface decorated with three dimensional facial indicia including one or more of (i) a pair of eyes, (ii) a nose or beak, and (iii) a mouth, as well as an aperture through which the linear material is spooled or unspooled. Claim 21 recites, *inter alia*, a facial indicia element having an exterior surface decorated with facial indicia to resemble one of an animal, a human, a human-like character, and an alien creature, as well as an aperture sized to closely receive spoolable linear material extending through the aperture. Claim 25 recites, *inter alia*, a facial indicia element having an exterior surface decorated with facial indicia to resemble one of an animal, a human, a human-like character, and an alien creature, as well as an aperture sized to closely receive spoolable linear material extending through the aperture. All of the independent claims recite that the aperture is within the facial indicia.

With the exception of dependent Claim 27, all of the claims are rejected as obvious over Hall alone. Hall does not teach or suggest facial indicia associated with a reel, much less facial indicia having the aforementioned claimed appearances or an aperture within the facial indicia

Appl. No. : **09/777,420**
Filed : **February 6, 2001**

and sized to closely surround spoolable linear material extending through the aperture. In fact, neither of the cited references teach or suggest anything about facial indicia at all, much less facial indicia including a functional aperture, as recited by Appellants' claims. In order to establish a *prima facie* case of obviousness over Hall, the Examiner must provide a suggestion or motivation in the prior art for modifying Hall to have facial indicia with the claimed appearances and an aperture therein as claimed. However, the Examiner has not identified any explicit statements in the prior art that might constitute such a suggestion or motivation. Nor has the Examiner provided any evidence that one of ordinary skill in the art had knowledge of applying facial indicia to a reel housing, much less knowledge of facial indicia with the claimed appearances or aperture having the recited function(s). The Examiner has not indicated that the modification flows naturally from the nature of the problem to be solved – improving the aesthetic appearance of a reel. Indeed, the goal of improving the aesthetic appearance of a reel does not naturally lead to the use of facial indicia, much less facial indicia with the claimed appearances or aperture having the recited function(s), as there are a large variety of ways to improve the appearance of a reel. The Examiner has not provided any evidence that the combined teachings of the prior art, knowledge of skilled artisans, and nature of the problem to be solved implicitly suggests facial indicia, let alone facial indicia having the claimed appearances and aperture having the recited function(s).

Rather than providing a specific suggestion or motivation in the prior art to modify Hall to include facial indicia with the claimed appearances and aperture, as required for a *prima facie* case of obviousness, the Examiner makes the following broad conclusory statements:

"That the exterior of the access panel has a facial indicia of an animal, human, or alien would have been an obvious matter of ornamental design choice to a person having ordinary skill in the art based on ornamental preference, providing no new or unexpected results. In other words, the ornamental design of the exterior surface of the access panel would have been an obvious matter of ornamental design choice to a person having ordinary skill in the art based on ornamental Preference, providing no new or unexpected results."

Final Office Action at p. 2. The Examiner further asserts:

"Applicant has provided no argument which proves that the particular claimed design, i.e. a facial indicia of an animal, human, or alien, is significant or is

Appl. No. : 09/777,420
Filed : February 6, 2001

anything more than one of numerous design configurations a person of ordinary skill in the art would find obvious for the purpose of ornamental design.”

Id. at p. 3. These conclusory statements do not constitute a specific suggestion or motivation to modify Hall. Nor do these statements provide the facial indicia element recited in Appellants’ claims. *See, M.P.E.P §706.02(k).* Stating that a recited functional limitation is “an obvious matter of design choice” is *not* a clear and particular showing, as required by *Dembiczak*. Whether the Examiner considers Appellants’ recited elements to be an “ornamental preference” is irrelevant to fulfilling the requirement of providing a specific suggestion or motivation in the prior art to modify Hall to include facial indicia and an aperture as claimed. The Examiner may consider the use of facial indicia and an aperture as claimed as being within the knowledge of skilled artisans. However, the Examiner has not provided any evidence of this assertion. Furthermore, it is improper for the Examiner to suggest or ask that Appellants show “new or unexpected results” unless the Examiner has *first* presented a *prima facie* case of obviousness, a burden that the Examiner has not met in the present case. *See, e.g., In re Papesch*, 137 U.S.P.Q. 43, 48-49 (CCPA 1963); *In re Wiechert*, 152 U.S.P.Q. 247 (CCPA 1967); M.P.E.P. §2144.09 (“A *prima facie* case of obviousness based on structural similarity is *rebuttable* by proof that the claimed compounds possess unexpectedly advantageous superior results.”) (emphasis added).

Thus, for all of these reasons, Appellants respectfully submit that the Examiner has not met his burden of establishing a *prima facie* case of obviousness for Claims 1-23, 25, and 28, because the record does not include any specific suggestion or motivation for modifying Hall to include the recited facial indicia and aperture.

D. With respect to Claim 27, the cited combination of references does not include all of the claimed limitations.

Claim 27 is rejected under 35 U.S.C. §103(a) as obvious over Hall in view of Ewald. Ewald is cited merely for the teaching of a spherical housing. Like Hall, Ewald does not teach facial indicia, much less facial indicia having the claimed appearances or an aperture within the facial indicia. Thus, the combination of Hall and Ewald does not include all of the claimed limitations. Further, the Examiner still has not provided a specific suggestion or motivation in the prior art for adding facial indicia, much less facial indicia with the claimed appearances and

Appl. No. : **09/777,420**
Filed : **February 6, 2001**

aperture having the recited function(s). Thus, the Examiner has not presented a *prima facia* case of obviousness of Claim 27.

E. Even if a reference disclosing facial indicia is combined with the cited references, a suggestion or motivation to combine would be required

Even if the Examiner, during future prosecution, were able to cite a new prior art reference teaching facial indicia having the claimed appearances and an aperture therein, the Examiner would still be required to provide a specific motivation or suggestion in the prior art for combining the new reference with Hall or any other prior art reference. Without the requisite suggestion or motivation to combine, a *prima facie* case of obviousness will not have been met.

C. Conclusion

The Examiner has failed to meet his burden of establishing a *prima facie* case of obviousness by not providing a suggestion or motivation in the prior art for modifying Hall to include all of Appellants' claim limitations. Appellants submit that all of the pending claims are allowable over Hall and the combination of Hall and Ewald. Accordingly, Appellants respectfully request that the pending claims be allowed.

IX. APPENDIX A

Attached hereto is a copy of the finally rejected claims in the present case that are the subject of this appeal.

X. APPENDIX B

Attached hereto is a copy of U.S. Patent No. 2,403,277 to Hall, the primary reference cited by the Examiner in all rejections.

XI. APPENDIX C

Attached hereto is a copy of U.S. Patent No. 2,286,904 to Ewald, a secondary reference cited by the Examiner in rejecting Claim 27.

Appl. No. : **09/777,420**
Filed : **February 6, 2001**

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 3/9/04

By: Sanjivpal S. Gill
Sanjivpal S. Gill
Registration No. 42,578
Attorney of Record
Customer No. 20,995
(415) 954-4114

W:\DOCS\DKJ\DKJ-3303.DOC
022304